

**REMARKS**

The Office Action dated April 6, 2004, has been reviewed and the Examiner's comments carefully considered. Prior to this paper, claims 1, 3-9, 11-13, 15-28, and 30-39 were pending. By this paper, Applicant adds claims 40-45. Therefore, claims 1, 3-9, 11-13, 15-28, and 30-45 are now pending.

Applicant respectfully submits that the present application is in condition for allowance for the reasons that follow.

**Rejections Under 35 U.S.C. § 102**

Claims 1, 3-6, 8-9, 11-13, 15-19, 21-26, 31-34 and 38-39 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,786,154 to Fantone et al. (hereinafter "Fantone"). In response, Applicant has made the above amendments to claims 1, 22 and 33, and respectfully submit that the above claims are allowable for at least the reasons that follow.

Applicants rely on MPEP § 2131, entitled "Anticipation – Application of 35 U.S.C. 102(a), (b), and (e)," which states that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." It is respectfully submitted that Fantone does not describe each and every element of any claim pending in the present case.

**Claim 1:** Claim 1 stands amended to recite that the controller is configured to adjust brightness of a plurality of regions of the image signal generated by the superimposition apparatus in response to measurements by the image measurement unit of the brightness of corresponding regions of the specimen image, **wherein the controller decreases the brightness of the plurality of regions when the brightness of the corresponding regions is measured to be dull.** (Emphasis added.) By way of an exemplary embodiment according to claim 1, if the corresponding regions of the specimen upon which the plurality of regions

of the image signal will be superimposed are dull, the corresponding regions of the image signal will also be dull.

In contrast, assuming *arguendo* that the device of Fantone measures brightness of a specimen and adjusts the brightness of a superimposed image, as is alleged in the Office Action, the device of Fantone operates in an opposite manner. If a region of the specimen is dull, the device of Fantone, under the above assumptions, would **increase** the brightness of the superimposed image. Thus, Fantone fails to teach the recitations of claim 1, and, in fact, Fantone teaches away from the present invention.

Furthermore, since Fantone fails to teach the recitations of claim 1, the claims dependent from claim 1 rejected as anticipated by Fantone are likewise allowable.

**Claim 33:** Claim 33, as amended, recites a controller that adjusts brightnesses to maintain substantially constant ratios of each of the brightnesses of the plurality of regions of the image signal to each of the brightnesses of the corresponding regions of the specimen image. In an exemplary embodiment according to claim 33, if the brightness of a region of the image signal is increased by a factor of two vis-à-vis the brightness of the respective specimen region, the brightness of other regions will likewise be increased by a factor of two vis-à-vis the brightness of the corresponding regions of the specimen.

In contrast, even under the assumptions detailed above regarding Fantone, the device of Fantone does not operate in such a manner. In Fantone, if a region of the specimen is dull, the device of Fantone would indeed **increase** the brightness of the superimposed image by a value to make the dull image “bright enough.” However, if a region of Fantone is not dull or less dull, the brightness of any superimposed image would not be increased by the same factor, ***if even increased at all***, since the goal of Fantone is to simply ensure that a user can see/identify otherwise hidden portions of a specimen. Fantone does not concern himself with portions of the specimen that may clearly be seen. Thus, Fantone fails to teach the recitations of claim 33.

Furthermore, since Fantone fails to teach the recitations of claim 33, the claims dependent from claim 33 rejected as anticipated by Fantone are likewise allowable.

**Claim 22** Claim 22 is allowable for the analogous reasons that make claim 1 allowable. Likewise, the claims that depend from claim 22 are allowable.

**Claim 34:** Claim 34 is allowable for the analogous reasons that make claim 33 allowable.

**Claim Rejections Under 35 U.S.C. §103(a)**

In the Office Action, Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Fantone in view of U.S. Patent No. 6,081,371 to Shioda et al. (hereinafter “Shioda”). Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Fantone in view of U.S. Patent No. 6,217,519 to Grund et al. (hereinafter “Grund”). Claims 27, 28, and 30 and 35-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fantone in view of U.S. Patent No. 5,307,202 to Martino et al. (hereinafter “Martino”).

Applicants rely on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the third criteria of MPEP § 2143 cannot be met vis-à-vis the amended claims in view of the rejections proffered in the Office Action.

**The Cited References Do Not Suggest All Claim Recitations**

Even if the first requirement of MPEP § 2143 was satisfied in the Office Action, the third criteria cannot be met. As seen above, Fantone does not teach or suggest each of the elements of independent claims 1, 22, and 33. The cited references do not remedy the deficiencies. Thus, the claims that depend or ultimately depend from claims 1, 22 or 33 are allowable for at least this reason.

Regarding claims 27 and 35: Claim 27 is allowable for the analogous reasons that make claim 1 allowable. Similarly, Claim 35 is allowable for the analogous reasons that make claim 33 allowable, as is detailed above. Moreover, Martino does not teach or suggest automatically adjusting any feature.

Martino does teach the use of software. However, simply because a device contains software does not mean that the device is automated. For example, say a computer contains software such as Microsoft Word. However, to print a document from Microsoft Word requires a user to click the “file” menu, then click “print,” and then click “ok.” Microsoft Word does not automatically print documents; the software merely makes the manual operation of printing software more efficient. Thus, Martino does remedy the deficiencies of Fantone with regard to claims 27 and 33, nor does Martino remedy the deficiencies of the claims that depend from claims 27 and 33

In sum, even if the first requirement of MPEP § 2143 may be satisfied by the proffered references, the third requirement of MPEP § 2143 cannot be satisfied, since the cited references do not teach each and every element of the present invention. Thus, the present claims are allowable.

### **New Claims**

As seen above, Applicant has added new claims 40-45. These claims are allowable for at least the reason that they depend from allowable claims.

### **Conclusion**

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,

to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Fineman is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date Sep 03, 2004

FOLEY & LARDNER LLP  
Washington Harbour  
3000 K Street, N.W., Suite 500  
Washington, D.C. 20007-5143  
Telephone: (202) 295-4747  
Facsimile: (202) 672-5399

By 

Martin J. Cosenza  
Attorney for Applicant  
Registration No. 48,892